



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

19281-00060US

"Express Mail" Label No.: **EV 720988980 US**
Date of Deposit: **December 1, 2005**

Application Number

09/687,151

Filed

October 12, 2000

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Signature

Cindy Bennett

First Named Inventor

John J. Sie et al.

Art Unit

2611

Examiner

Brown, Rueben M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

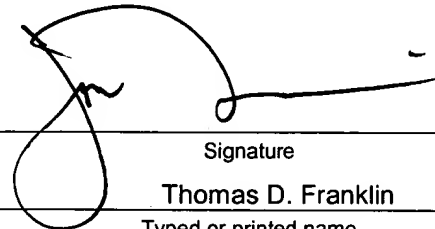


attorney or agent of record.

Registration number **43,616**

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34. _____


Signature
Thomas D. Franklin
Typed or printed name

303.571.4000

Telephone number

December 1, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of _____ pages in this submission.



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PATENT
Docket No.: 019281-000600US

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MAIL STOP: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By: _____

Cindy Bennett
Cindy Bennett

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

John J. Sie et al.

Application No.: 09/687,151

Filed: October 12, 2000

For: PRE-STORING A PORTION OF A
PROGRAM TO ALLOW USER
CONTROL OF PLAYBACK

Confirmation No.: 8606

Examiner: Brown, Rueben M.

Art Unit: 2611

**PRE-APPEAL BRIEF
REQUEST FOR REVIEW**

MAIL STOP: AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants respectfully request review of the final rejection mailed by the Office for the above-referenced application on July 14, 2005 ("the Final Office Action"). An Advisory Action was mailed on November 3, 2005 indicating that the Response filed on September 14, 2005 under 37 C.F.R. §1.116 ("the Response") did not place the application in condition for allowance. Appellants believe the rejections contain clear factual deficiencies and do not properly set forth a *prima facie* rejection.

A Notice of Appeal is being filed concurrently herewith. This Request for Review is pursued for the reasons given below.

STATUS OF CLAIMS

Claims 1-13 and 21-22 stand rejected under 35 U.S.C. §103(a) as unpatentable over the cited portion of U.S. Pat. No. 5,530,754 to Garfinkle (hereinafter "Garfinkle"). The Examiner has additionally cited U.S. Patent No. 5,721,815 to Ottesen et al. (hereinafter "Ottesen"). For the purposes of this Request for Review, Appellants presume that Garfinkle and Ottesen are combined in a §103 rejection as outlined in the Advisory Action, page 3, last paragraph. Claims 14-20 are withdrawn from consideration.

REVIEW REQUESTED FOR THE FOLLOWING REASONS

Official Notice in Combining Garfinkle and Ottesen Not Shown

Apparent official notice was originally set forth in the Final Office Action, page 5, last paragraph. Appellants duly note in the Response that no cite is given for the motive to combine Garfinkle and the Official Notice in the Final Office Action. Further, the Advisory Action reiterates this apparent official notice on page 2, last sentence, without giving any cite. The Office must provide a cite or affidavit to support this apparent official notice upon a request for a showing of proof by Appellants. A *prima facie* rejection is not properly set forth without such a showing of proof.

As understood by Appellants, Official Notice or Ottesen is combined with Garfinkle, to enable "longer durations of the lead-in segments to be stored on the receiver," such as 30 minutes, 60 minutes or more. Buffering for 30-60 minutes or more to deliver a program is not believed reasonable. The buffer would nearly be the size of complete delivery, which obviates the whole reason to perform buffering. Respectfully, this unsupported motive doesn't make sense.

Motive to Combine Garfinkle and Ottesen Not Proper

Both Garfinkle and Ottesen teach away from a system that would buffer 30 minutes of programs as suggested combination of Garfinkle and Ottesen would require. This hypothetical combination would have 30 minute buffering of programs in

the catalog. There is indications in Garfinkle that there would be a "large number of video products" available. Garfinkle, col. 1, lines 46-47. Some of these would have a 30 minute lead-in. This would require huge amounts of storage, that both Garfinkle and Ottesen are both trying to avoid. By defeating the very purpose of these references, the suggested combination makes no sense.

Garfinkle indicates that "due to storage limitations, only certain video products will include trailers, for example the ten most popular releases" would include trailers. Garfinkle, col. 4 lines 9-12. Trailers are 30-120 seconds and Garfinkle indicates that storage is at such a premium that storage of only ten is reasonable. Worst case, this would require 20 minutes of storage for ten movies. In this combination of Garfinkle and Ottesen, the Office takes the position that 30 minute lead-in portions of the videos taught in Ottesen would be stored in the catalog of Garfinkle. Clearly, if Garfinkle is worried about only storing 2 minute or less trailers for the ten most popular movies "due to storage limitations," extending Garfinkle to store 30 minute lead-ins for most movies in the catalog is unreasonable. Indeed, just one lead-in for one movie in the catalog would consume more than all the trailers.

Similarly, Ottesen is concerned with storage of excessive amounts of video that would be required by the Office's proposed combination of Garfinkle and Ottesen. Ottesen states that "the excessively large memory requirement of these . . . storage systems . . . is prohibitively expensive for the average consumer." Ottesen, col. 2, lines 56-67. Ottesen proposes solving this problem by storing a single 30 minute segment (see Ottesen, Fig. 21) rather than the many that would be required by the proposed Garfinkle/Ottesen-type system. In the face of this stated purpose of Ottesen, the Office is trying to use Ottesen in a system that would require storing many 30 minute segments, which negates its very purpose.

Clearly, a combination that would subvert goals of the two primary references is not reasonable. The state combination of Garfinkle and Ottesen is believed improper for this reason.

Combining Garfinkle and Ottesen Does Not Read On Claims

The Final Office Action, as embellished by the Advisory Action, apparently takes the position that a Garfinkle system would have buffering of 30 minutes like Ottesen when combined. Appellants respectfully believe that this combination is unduly guided by their claims and not the prior art. Hindsight reconstruction leads to this combination as the more reasonable combination of these references would not read on the claims.

A more plausible Garfinkle-Ottesen combination would have both 2 minute lead-ins for catalog programs and 30 minute segment to allow trick play (e.g., fast-forward, rewind, pause) for the single program selected for playback. This system would still only have a 2 minute first portion and not a 15 minute or 1/8 first portion as the claims require. Picking and choosing elements of these two references is simply improper without some specific motivation to modify the references in the suggested manner. As one of ordinary skill in the art would not make the combination suggested by the Office, only impermissible hindsight reconstruction can explain the selective mixing of elements from Garfinkle and Ottesen proposed by the Office.

Showing of Proof Not Provided for Official Notice In Rejecting Claim 7

Apparent official notice is also relied upon in rejecting Claim 7. Specifically, laserdiscs or DVDs that could store video in a VOD system are not believed to have been widely known as is asserted in the Final Office Action. A showing of proof was requested in the Response, but none was provided in the Advisory Action. The Office is respectfully requested to provide an express showing of proof for this proposition as set forth in MPEP 2144.03.

Ottesen is Not Officially of Record in the Present Case

The Office has apparently substantively relied upon Ottesen, but has not cited the reference properly in the record. Appellant has attached hereto a PTO/SB/08A form citing Ottesen into the file history. The fee associated with submitting an

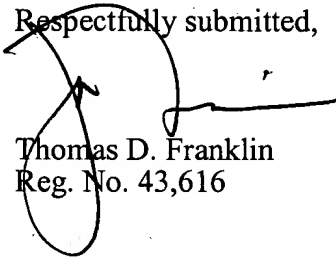
Information Disclosure Statement is not believed appropriate in this situation. Initialing the form and entering it into the file history is respectfully requested.

CONCLUSION

In view of the foregoing, Appellants believe all claims now pending in this Application are in condition for allowance. Specifically, claims 1-13 and 21-22 are allowable for at least the reasons cited above. Reconsideration is respectfully requested. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Thomas D. Franklin
Reg. No. 43,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: (415) 576-0200
Fax: (415) 576-0300
TDF:cmb



INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)			Complete if Known		
			Application Number	09/687,151	
			Filing Date	October 12, 2000	
			First Named Inventor	Sie, John J.	
			Art Unit	2611	
			Examiner Name	Brown, Rueben M.	
Sheet	1	of	1	Attorney Docket Number	019281-000600US

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number Kind Code ² (if known)			
	AA	US-5,721,815	02-24-1998	Ottesen et al.	
	AB	US-			
	AC	US-			
	AD	US-			
	AE	US-			
	AF	US-			
	AG	US-			
	AH	US-			
	AI	US-			
	AJ	US-			

FOREIGN PATENT DOCUMENTS								
Examiner Initials*	Cite No. ¹	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³	Number ⁴	Kind Code ⁵ (if known)				
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	AL							<input type="checkbox"/>
	AM							<input type="checkbox"/>
	AN							<input type="checkbox"/>
	AO							<input type="checkbox"/>

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials *	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	AP		<input type="checkbox"/>
	AQ		<input type="checkbox"/>
	AR		<input type="checkbox"/>

Examiner Signature		Date Considered	
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* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.